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|--|-------------|----------------------|---------------------|------------------|
| 10/539,148   | 06/16/2005  | Morgan Kanflod       | AC-100              | 9266             |
| 7590   |             | 03/08/2011           |                     |                  |
| Mark P. Stone<br>Attorney at Law<br>50 Broadway<br>Hawthorne, NY 10532 |             |                      |                     |                  |
|  |             |                      | EXAMINER            |                  |
|  |             |                      | MACARTHUR, VICTOR L |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 3679                |                  |
|  |             |                      | MAIL DATE           | DELIVERY MODE    |
|  |             |                      | 03/08/2011          | PAPER            |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Interview Summary

**Application No.**

10/539,148

**Applicant(s)**

KANFLOD ET AL.

**Examiner**

VICTOR MACARTHUR

**Art Unit**

3679

All participants (applicant, applicant's representative, PTO personnel):

(1) VICTOR MACARTHUR.

(3) \_\_\_\_\_.

(2) Mark Stone.

(4) \_\_\_\_\_.

Date of Interview: 04 March 2011.

Type: a) ☒ Telephonic b) ☐ Video Conference

c) ☐ Personal [copy given to: 1) ☐ applicant

2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☒ No.

If Yes, brief description: \_\_\_\_\_.

Claim(s) discussed: N/A.

Identification of prior art discussed: N/A.

Agreement with respect to the claims f) ☐ was reached. g) ☒ was not reached. h) ☐ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: See Continuation Sheet.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN A NON-EXTENDABLE PERIOD OF THE LONGER OF ONE MONTH OR THIRTY DAYS FROM THIS INTERVIEW DATE, OR THE MAILING DATE OF THIS INTERVIEW SUMMARY FORM, WHICHEVER IS LATER, TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

/Victor MacArthur/  
Primary Examiner, Art Unit 3679

## Summary of Record of Interview Requirements

### Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record

A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview.

### Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews

Paragraph (b)

In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135 (35 U.S.C. 132)

#### 37 CFR §1.2 Business to be transacted in writing.

All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiners Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:

- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case. It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

- 1) A brief description of the nature of any exhibit shown or any demonstration conducted,
- 2) an identification of the claims discussed,
- 3) an identification of the specific prior art discussed,
- 4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
- 5) a brief identification of the general thrust of the principal arguments presented to the examiner,  
(The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
- 6) a general indication of any other pertinent matters discussed, and
- 7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

### Examiner to Check for Accuracy

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiner's version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place the indication, "Interview Record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.

Continuation of Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments:

Applicant's representative noted receipt of the advisory action mailed 3/4/2011 and stated that while the advisory action noted that the 1/21/2011 After Final amendment was not entered, there was no mention of the 1/21/2011 Declaration included therewith. The examiner stated that the 1/21/2011 reply, including the declaration, was not entered. While not stated in the advisory action, the examiner noted that the declaration was untimely (after final) and was not accompanied by good and sufficient reasons why it was not filed early (e.g., before final rejection when the new matter limitation, to which the declaration is argued to address, was amended into the claims).

Furthermore, the examiner stated that applicant's after final submission stated that the declaration shows what "a person of ordinary skill in the relevant art, rock drilling, would clearly recognize from the original Specification" (p.5, para.2, 1/21/2011 after final submission) rather than pointing out where the originally filed application provided clear antecedent basis for the new matter limitation noted in the previous office action rejection. Accordingly, it appears even if considered, the declaration would be completely irrelevant to the New Matter rejection under 35 U.S.C. 112 1<sup>st</sup> paragraph written description requirement.

The examiner stated that the question of what one of ordinary skill would know or "recognize", while being pertinent to motivation for obviousness or even to show enablement under 35 U.S.C. 112 1<sup>st</sup> paragraph; has no bearing on the written description requirement under 35 U.S.C. 112 1<sup>st</sup> paragraph. Note that while both written description and enablement fall under 35 U.S.C. 112 1st they are distinct from each other. New Matter under the written description requirement is a purely factual inquiry: either the originally filed application provides clear antecedent basis for a limitation or it does not. The examiner set forth a simplified analogy: If applicant added a new matter limitation --the rock bolt being painted yellow--, applicant could not overcome a 112 1<sup>st</sup> written description new matter rejection by submitting evidence that one of ordinary skill knows and understands that rock bolts are commonly painted yellow. Such evidence may be pertinent to a showing of obviousness or enablement but not to compliance with the written description requirement. As it pertains to the current case, applicant cannot fulfill the written description requirement regarding the new matter limitation "is loaded to retain...only" by submitting evidence that one of ordinary skill would have found such a limitation to be obvious, understood to be common, etc.

Furthermore, the examiner noted that if one of ordinary skill should see such a limitation so commonly and clearly present in applicant's rock drill structure without express recitation in the originally filled application then why wouldn't such a limitation be obvious or even inherent to the prior art combination set forth by the Board of Appeals (see decision mailed 8/2/2010)? If there is some structural difference between applicant's originally disclosed invention and that of the prior art combination, the examiner suggested amending such structure in the claims (what structure causes "loaded to retain... only" and why isn't such structure if any in the claims? The examiner suggested filing a CIP if applicant truly needed the new matter intended use limitation for patentability (which, ironically, by applicant's own description of the declaration appears obvious and/or inherent to one of ordinary skill in the art).